

JUL 27 2007

Application No. 10/784,197
Responsive to the Office Action of November 29, 2006

*Docket No.: 0445-0347P***REMARKS**

Claims 1 and 4-12 remain pending after this response.

Claim Amendments

The claims are amended to provide for the presence of "cut fragments". Support for this amendment resides in the claims as previously presented. No new matter is added by this amendment.

Rejection under 35 USC 103(a)

Claims 1-2 and 4-12 stand rejected under 35 USC 103(a) as being unpatentable over Torigoshi JP '528 (see pages 3-5 of the outstanding Office Action). This rejection is respectfully traversed.

By way of review, in the claimed invention the elastic members each have (a) a portion contributory to elastic extensibility and contractibility in each of the regions *outside* the lateral sides of the patterned sheet, *and* (b) a portion substantially *non-contributory* to elastic extensibility and contractibility in the region *inside* the lateral sides of the patterned sheet.

Further, as can be seen from Figure 3 in applicants' specification, the elastic members 24 in front and back portions A and B, respectively, are a continuation of elastic members 23. However, the elastic members 24 reside in the portion F (the middle portion between lateral portions E). The present invention thus has "the portion substantially non-contributory to elastic extensibility and contractibility [is] disposed between the patterned sheet and the inner sheet"

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(see the location of feature (b) as recited in claim 1). Also, the elastic members 24 in portion F of the present invention are present *as cut fragments of elastic members* (see Fig. 3), as also recited in claim 1. *The presence of such cut fragments of the elastic members in the recited location of the diaper reduces the tendency of the diaper to contract over the area F.*

In addition, the elastic members of the present invention reside between the patterned sheet and the inner sheet. This can be seen from Figure 3, where sheet 21 is the outer sheet and sheet 22 is the inner sheet. *These structural features allow a picture or pictorial pattern to be clearly seen from the outside, as the cut fragments are generally rendered less visible by the adjacent picture or pictorial pattern.*

The advantages of the present invention are discussed at page 6, line 26 to page 7, line 10 of the specification.

The claimed invention is neither disclosed nor suggested by the cited prior art.

In the Advisory Action, the Examiner takes the position that applicants' arguments in support of patentability do not place the application in condition for allowance. The Examiner states as follows in the Advisory Action:

"Applicants' arguments filed 2/28/07 have been fully considered but are not persuasive. Applicant argues Torigoshi U.S. Patent application Publication 2004/0030317 fails to teach or suggest that the limitations wherein the portion substantially non-contributory to elastic extensibility and contractibility are cut ends or a fragment or both resulting from cutting the elastic members. Applicant further argues Torigoshi does not disclose the recited method of producing the same. The method of forming the device is not germane to the issue of patentability of the device itself. Torigoshi teaches elastic members 527, 528, and 527a, and specifically in the front of the diaper where the patterned sheet can be observed, the elastic members 527, 527a have cut ends (Figures 32 and 34). If the elastics are not present, they characteristically are not contributing to elastic extensibility and contractibility in that region. Applicant additionally argues that

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it is not clear or clearly disclosed in Torigoshi if its pictorial pattern is clearly seen from an outside point of view. Figure 1 of Torigoshi shows the graphic viewable from the external sheet 120, further Torigoshi teaches the character corresponding to the front and back of a product so as to be easily distinguishable by anyone at a glance, which clearly indicates the graphic is viewable from the outside. Applicant additionally argues the cited modification of Torigoshi does not result in a patterned sheet having a pattern is disposed between the outer sheet and the inner sheet as instantly claimed. As stated in the Final Office Action, mailed 11/29/06, Torigoshi discloses a patterned sheet 100 having a pattern disposed between the outer sheet and the inner sheet, which is taught in paragraph 0259. Regarding the total transmittance value, applicant argues the Examiner has not provided any scientific or technical evidence to show that this feature is a matter of routine skill in the art. The Examiner respectfully disagrees. The Examiner has relied on Jordan as showing a high light transmittance value is known in the art for an outer cover graphic. Based on the teaching of a high transmittance value, the examiner maintains that optimizing the opacity of the film, filler material, or density of the material involves routine skill in the art."

Despite the Examiner's statements, the cited reference does not teach or suggest the presence of cut fragments 25 as intended by applicants' claim 1, and as depicted at applicants' Figure 6. In order to clarify this distinction, claim 1 is amended to require the presence of "cut fragments", an embodiment neither taught nor suggested by the cited reference.

It is noted that claim 1 previously recited the alternative presence of "cut ends" or "cut fragments" of elastic members, or both. The Examiner appears to consider the ends of elastic members 1527a (Figure 48) or the ends of elastic members 1627a (Figure 49), for example, to have met this limitation. That is, the Examiner appears to have considered the ends of elastic members 1527a or 1627a to be "cut ends". Claim 1, as now amended, now requires the presence of cut "fragments", as opposed to cut "ends", in order to more clearly distinguish over the teachings of the reference. It is apparent that the cited reference fails to teach such an embodiment.

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For example, Torigoshi '528 fails to teach or suggest that the portion substantially non-contributory to elastic extensibility and contractibility includes cut fragments resulting from cutting the elastic members. Instead, Torigoshi '528 only discloses the structure of a diaper, and does not disclose the recited method of producing same. Therefore, the reference fails to teach or suggest that the portion which is non-contributory to elastic extensibility and contractibility is formed by cutting, when the elastic members are not arranged at the central portion of the absorbent member, and are arranged at the right and left side portions of the absorbent member. For this reason, it is difficult to determine from the teachings of the reference whether the cut ends are "a portion non-contributory to elastic extensibility and contractability" consistent with the cut ends of applicants' claimed invention.

The Examiner states in the Advisory Action that "The method of forming the device is not germane to the issue of patentability of the device itself". Applicants differ with this conclusion to the extent that the disclosed method is so distinguishable from that taught by applicants that the claimed product could not be produced by the prior art method. In such a circumstance, it is clear that the prior art reference could not suggest a product if the product could not be made by the method taught by the reference.

It is noted that Torigoshi '528 discloses at paragraph [0259] that the design sheet 100 can be interposed between the external sheets consistent with the claimed invention. Elastic members are arranged between the external sheets. The Examiner takes the position that it is obvious to arrange a patterned sheet at the outer side of the elastic members as occurs in the claimed invention. However, as mentioned above, Torigoshi '528 fails to disclose whether or not there is

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“a portion non-contributory to elastic extensibility and contractability” where the cut fragments of the elastic members are located. Consequently, Torigoshi ‘528 neither discloses nor suggests that a patterned sheet is disposed at the outer side of the elastic members.

The reference seeks to provide a disposable diaper having a neat appearance around the leg portions with fringes of leg portions which are not fluttering. Thus, the intent is not to show a pattern in such a manner that it can be clearly seen through from the outside, as in the claimed invention.

For instance, applicants note that elastic members in the present invention reside between the patterned sheet and the inner sheet. Further, as can be seen from Figure 3, sheet 21 is the outer sheet and sheet 22 is the inner sheet. These structural features allow a picture or pictorial pattern to be clearly seen from the outside. Such features are not disclosed in Torigoshi ‘528. It is not even clear or clearly disclosed in Torigoshi ‘528 if the pictorial pattern (e.g., a picture of a dog) is clearly viewable from an outside point of view.

Accordingly, applicants respectfully submit that the cited modification of Torigoshi ‘528 still fails to disclose all instantly claimed features and a *prima facie* case of obviousness has not been established. A proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have

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been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). In this regard, not even the initial requirement of disclosure of all claimed features has been satisfied.

For instance, the cited modification of Torigoshi '528 does not result in a patterned sheet having a pattern is disposed between the outer sheet and the inner sheet as instantly claimed.

Applicants add that the requisite motivation as well as the reasonable expectation of success are lacking. With regard to the required level of motivation, the location of the portion that is substantially non-contributory to elastic extensibility and contractibility aids in bringing about a pictorial pattern clearly seen from the outside of the absorbent article. Such a feature or description is missing in the cited Torigoshi '528 reference.

With regard to the requisite reasonable expectation of success, Torigoshi '528 merely discloses a picture on its diaper in Figure 1. Therefore, applicants respectfully submit that such a generic description does not lead one of ordinary skill in the art to experiment enough such that the claimed invention could be achieved. In this regard, applicants respectfully submit that it is not *prima facie* obvious to modify a reference unless the reference suggests an advantage to be gained from the modification. *See In re Sernaker*, 217 USPQ 1, 6 (Fed. Cir. 1983). That suggestion is missing in Torigoshi '528. Thus, applicants respectfully submit that the required level of reasonable expectation of success is lacking.

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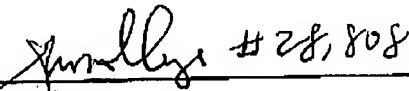
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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